

Appl. No. 09/634,356
Amdt. dated September 16, 2004
Reply to Office Action of July 26, 2004

Remarks

The present amendment responds to the final Official Action dated July 26, 2004. The Official Action rejected claims 1, 2, 17-19, and 22 under 35 U.S.C. §102(e) based on Oda U.S. Patent No. 6,490,464 (Oda). Claims 1-4 and 20-22 were rejected under 35 U.S.C. §103(a) based on Fuji et al. U.K. Patent Application No. GB 2251357A (Fuji) in view of Oda. Claim 6 was rejected under 35 U.S.C. §103(a) based on Fuji in view of Oda, and further in view of Boesen U.S. Patent Application Publication No. US 2001/0027121 (Boesen). Claim 24 was rejected under 35 U.S.C. §103(a) based on Fuji in view of Dornier et al. U.S. Patent No. 5,579,489 (Dornier) and further in view of Oda. Claims 5 and 7-16 were objected to as being dependent upon a rejected base claim but were indicated to be allowable if rewritten in independent form. These grounds of rejection are addressed below following a brief discussion of the present invention to provide context.

Claim 23 was previously cancelled without prejudice. Claim 17 has been amended to be more clear and distinct. More particularly, claim 17 has been amended to add the limitation “to the basic telephone module during intervals when the basic telephone module has sufficient idle processing capacity available to receive the subscriber information,” a limitation which is similar to the limitation “passing processed data to the basic telephone module during intervals when the basic telephone module has sufficient idle processing capacity available to receive the data” found in claim 1. Thus, this amendment should not require further search and should be entered, placing the case in order for allowance or in better order for appeal. Claims 1-22 and 24 are

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presently pending with claims 5 and 7-16 indicated to be allowable if rewritten in independent form.

The Present Invention

A wireless telephone according to one aspect of the present invention has two separate modules, each preferably comprising a processor, an accompanying chipset adapted for use with and support of that processor, and a separate internal bus for communication between the processor and chipset. The first module is a basic telephone module optimized for performing time critical processes needed for operation of a wireless telephone such as basic telephone functions. The first module also is capable when operating in a non-optimized mode to perform non time critical enhanced features. The second module is an enhanced services module optimized for performing non time critical processes which both reduces the load on the first module and adds features to the telephone. For example, the second module may add a second keypad and display and take over control of keypad and display functions thereby reducing the load on the first module. Additionally, functions not supported by the first module, such as programmable rings, speed dial, PDA functions and the like may also be added.

The great majority of non time critical functions are managed by the enhanced services module, without a need for the basic telephone module to divert processing resources away from time critical processes. In response to detecting the connection of the enhanced services module to the basic services module, the basic services module transfers the operation of non time critical functions to the enhanced services module to result in optimal performance of the basic

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telephone module. To effect the transfer of functions, the non time critical functions are disabled on the basic services module and are enabled on the enhanced services module.

The enhanced services module transfers data among supporting components on its internal bus. The basic telephone module and the enhanced services module exchange instructions and data through an interface module during intervals when the basic basic telephone module has sufficient idle processing capacity available. Through the interface module, data may be sent to indicate the transfer of processing of non time critical functions between the basic telephone module and the enhanced services module. Among its several advantages, this arrangement allows a user to purchase and retain an enhanced services module suited to his or her needs, and then to use that enhanced services module with a different or upgraded basic telephone module.

The Art Rejections

As addressed in greater detail below, Oda, Fuji, Boesen, and Dornier do not support the Official Action's reading of them and the rejections based thereupon should be reconsidered and withdrawn. Further, the Applicant does not acquiesce in the analysis of Oda, Fuji, Boesen, and Dornier made by the Official Action and respectfully traverses the Official Action's analysis underlying its rejections.

Claims 1, 2, 17-19, and 22 were rejected under 35 U.S.C. §102(e) based on Oda. Oda describes a mobile telephone adaptable to receive a smart card to translate key input into a character or a sequence of characters to achieve a common operational method for inputting

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characters into a mobile phone. One operational approach described at col. 1, lines 43-57 of Oda includes inputting characters to a mobile phone. For example, the letter "b" may be inputted by pressing the key labeled "2" twice. Furthermore, Oda's system supports translating a keyed input into a Chinese character. Oda, col. 2, lines 5-9. Referring to Fig. 2 of Oda upon which the Official Action relies, Oda's system includes a mobile telephone 11 and a smart card 12. When a key is pressed on the keypad of the mobile telephone 11, the operational information corresponding to the pressed key is transmitted to the smart card 12. A program running in the smart card 12 translates the operational information into a character or character string. Oda, col. 4, line 67 – col. 5, line 9. The character or character string is transmitted back to the mobile telephone where it may be stored in working memory 21 or displayed at display 22. Oda's approach adds a mapping function to a mobile telephone to allow different type mobile telephones to support the same operational method, a very different problem than what is addressed by the present invention.

In contrast, the wireless telephone, according to claim 1 of the present invention, for example, has both a basic module and an enhanced services module. In one aspect, the present invention advantageously improves performance by disabling non-time critical functions which were operating on the basic module and enabling those same disabled functions to execute on the enhanced services module. The performance of the wireless telephone may be further increased because data that is passed from the enhanced services module to the basic module is passed so when the basic telephone module has sufficient idle processing capability.

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Turning to the language of the claims, claim 1 recites "in response to detecting the connection of the connected enhanced services module, the basic telephone module disabling the group of non time critical functions being performed by the basic telephone module, and enabling the group of non time critical functions to be performed by the enhanced services module." See also claim 17 where it recites "detecting the connection of the enhanced services module; and transferring the performance of said non time critical functions to the enhanced services module, in response to detecting the connection of the enhanced services module to the basic telephone module." Claim 1 further recites "processing the data and passing processed data to the basic telephone module during intervals when the basic telephone module has sufficient idle processing capacity available to receive the data." See also, claims 18, 19, 22, and 24.

The Official Action relies on the text at col. 5, line 38 – col. 6, line 25 and col. 10, lines 23-37 of Oda as purportedly disclosing processing the data and passing processed data to the basic telephone module during intervals when the basic telephone module has sufficient idle processing capacity to receive the data. Applicant respectfully disagrees. Oda discloses translating keyed input to a character or character string. The character or character string is transmitted when "a character or character string corresponding to operational information is specified." Oda, col. 5, lines 63-65. Thus, Oda transmits the character or character string once the mapping has taken place without regards to the processing capacity of the mobile telephone. Oda does not disclose "processing the data and passing processed data to the basic telephone module during intervals when the basic telephone module has sufficient idle processing capacity available to receive the data," as claimed in claim 1. (emphasis added). Oda merely addresses

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adding the mapping function through the smart card without disabling an equivalent feature on the mobile telephone as claimed.

At col. 6, lines 17-25 of Oda, the cited portion of text addresses how the smart card possibly "suppresses increases in the processing load of the microprocessor 20 of the mobile telephone 11" when handling Chinese characters. (emphasis added) The cited text suggests that a mobile telephone modified to handle Chinese characters without a smart card would increase the processing at the mobile telephone. The implication is that the smart card is adding an additional feature that is not typically performed by the mobile device. Unlike Oda, the present invention addresses a performance feature which shifts the processing of non-time critical functions to the enhanced services module to lessen the processing burden on the base module. Oda does not disclose "in response to detecting the connection of the connected enhanced services module, the basic telephone module disabling the group of non time critical functions being performed by the basic telephone module, and enabling the group of non time critical functions to be performed by the enhanced services module," as claimed in claim 1. (emphasis added) Oda does not disclose "transferring the performance of said non time critical functions to the enhanced services module, in response to detecting the connection of the enhanced services module to the basic telephone module," as claimed in claim 17.

Turning to claims 2 and 19, the Official Action repeatedly applies an inherency argument. With regard to claim 2, the Official Action states that "it is inherent that the telephone comprises an interface module for transferring data between the basic telephone module and the enhanced services module." With regard to claim 19, the Official Action states "it is inherent that an older

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enhanced services module may have been removed from the basic telephone.” Applicants respectfully disagree.

According to the MPEP Section 2112, “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” The MPEP continues by further stating “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art,” citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Examiner has not met this burden here. As addressed above, Oda merely addresses the problem of providing a mapping of operational information to a character or character string so that different type mobile telephones can perform similar operational methods. As such, Oda’s mobile telephone and smart card operate in a very different manner than the basic telephone module and enhanced service module as claimed. Thus, the operation cited as inherent does not necessarily flow from the teachings of Oda as required by the case law.

In contrast to Oda, claim 2 of the present invention recites “an interface module for transferring data between the basic telephone module and the enhanced services module.” In contrast to Oda, claim 19 of the present invention recites “detecting the connection of the new enhanced services module; and transferring the processing of the group of non time critical

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functions to the new enhanced services module, in response to detecting the connection of the enhanced services module to the basic telephone module.” Simply put, the presently claimed approach is not disclosed and is not rendered inherent by Oda.

Claims 1-4 and 20-22 were rejected under 35 U.S.C. §103(a) based on Fuji in view of Oda. Fuji fails to cure the deficiencies of Oda. Fuji describes a radiotelephone terminal and an external device for communicating subscriber information between devices. Fuji, Abstract. From the perspective of the radiotelephone terminal, the external device acts as a “main memory bank” or a “memory card” because only data such as subscriber information is being transferred between the two devices. See Fuji, page 17, lines 18-19 and page 19, line 27, respectively. Referring to Fig. 16 and page 23, line 15 through page 24, line 8 on which the Official Action relies, Fuji addresses rewriting data such as subscriber information stored in storage unit 46 of an external unit with subscriber information sent from keypad 35a. In so doing, the data is transferred from the keypad 35a to the external device. Further, Fuji provides the ability of reading the subscriber information data from the storage unit 46.

The Official Action admits at page 6, para. 2 that Fuji does not disclose the claimed feature “in response to detecting the connection of the connected enhanced services module, the basic telephone module disables the group of non-time critical functions being performed by the basic telephone module, and enabling the group of non time critical functions to be performed by the enhanced services module.” The Official Action relies on Oda for these features. As described above, Oda does not disclose “in response to detecting the connection of the connected enhanced services module, the basic telephone module disabling the group of non time critical

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functions being performed by the basic telephone module, and enabling the group of non time critical functions to be performed by the enhanced services module,” as claimed in claim 1.

According to MPEP §706.02(j), to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Official Action suggests combining Fuji and Oda “such that in response to detecting the connection of the connected enhanced services module, the basic telephone module disables the group of non time critical functions begin performed by the basic telephone module, and enabling the group of non time critical functions to be performed by the enhanced services module, in order to automatically relieve the basic telephone module of the burden of performing the non time critical functions upon the connection with the enhanced services module.” This proposed combination does not meet any of the three steps required to establish a *prima facie* case. The motivation is not found in Oda or Fuji, there is no reasonable expectation of success when seeking to combine teachings from a key stroke translator and an external subscriber information device to achieve a quit different overall arrangement, and the only suggestion of the

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overall claimed combination and is found solely in the Applicant's own claims and the Applicant's own disclosure.

Claim 6 was rejected under 35 U.S.C. §103(a) based on Fuji in view of Oda, and further in view of Boesen. Since claim 6 depends from and contains all the limitations of claim 1 as presently amended, claim 6 distinguishes from the references in at least the same manner as claim 1.

Claim 24 was rejected under 35 U.S.C. §103(a) based on Fuji in view of Dornier and further in view of Oda. Dornier fails to cure the deficiencies of Fuji and Oda described above. Dornier describes a handheld portable computer which has an interface to communicate directly over a bus with a host computer or a printer, for example. The Official Action apparently relies on this aspect of Dornier to purportedly suggest that Fiji should have any enhanced services module having an optional hardware component. Dornier does not address mobile telephones and there is no apparent non hindsight motivation to combine Dornier with Fuji in the manner suggested by the Examiner.

Fuji, Dornier, and Oda, either separately or in combination, do not teach and do not suggest "passing processed data to the basic telephone module during intervals when the basic telephone data has sufficient idle processing capacity available to receive the data," as claimed in claim 24.

Furthermore, Fuji, Dornier, and Oda, either separately or in combination, do not teach and do not suggest "the basic telephone module detecting the connection of the enhanced services module to the basic telephone module, in response to detecting the connection of the enhanced

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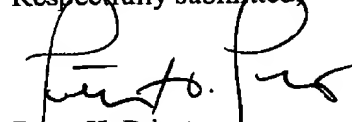
services module, the basic telephone module disabling a non time critical function being performed by the basic telephone module, and enabling the non time critical functions to be performed by the enhanced services module," as presently claimed in claim 24.

The relied upon references fail to recognize and address the problems of enhancing the performance of a base telephone module by off loading existing function to the enhanced services module in the manner advantageously addressed by the present claims. The claims as presently amended are not taught, are not inherent, and are not obvious in light of the art relied upon.

Conclusion

All of the presently pending claims, as amended, appearing to define over the applied references, withdrawal of the present rejection and prompt allowance are requested.

Respectfully submitted,



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